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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,919

07/28/2003

Paul L. Baker

907.0002

3616

25534

7590

04/04/2007

CAHN & SAMUELS LLP
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WASHINGTON, DC 20036

EXAMINER

OBEID, MAMON A

ART UNIT

PAPER NUMBER

3609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/627,919

Applicant(s)

BAKER, PAUL L.

Examiner

Mamon A. Obeid

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/07/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This is in reply to application filed on 07/28/2003.
2. Claims 1-5 are presented for examination on the merits.

Priority

3. Applicant's claim for the benefit of a U.S Provisional Application serial No. 60/399,189, filed July 30, 2002 is acknowledged.

Information Disclosure Statement

4. The Information Disclosure Statement filed on 12/07/2006 has been considered.
An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "capable of" does not recite a method step because it only indicates that the method step may or may not be carried out.
7. The term *capable of* in claim 1 is a relative term, which renders the claim indefinite. The term *capable of* is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "capable of" does not recite a method step because it only indicates that the method step may or may not be carried out.
8. Claim 1 recites the limitation *said services* in line 7. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 2 recites the limitation *said encrypted files* in line 10. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites the limitation of *said keywords* and *said encrypted vocabulary*. However this claim depends from

claim 1 which states that both files are each encrypted. The limitations of claim 4 therefore appear to be in contradiction with the limitations of claim 1. For the purposes of this examination, the Examiner will assume that both the keywords and the vocabulary are both encrypted.

11. Claim 4 recites the limitation *said keywords* in line 16. There is insufficient antecedent basis for this limitation in the claim.
12. Claim 4 recites the limitation *said encrypted vocabulary* in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1- 5 are rejected under 35 U.S.C. 102(e) as being anticipated by De Vries, U.S Publication No. US 2002/0184153 A1.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 1:

De Vries, as shown below, discloses the following limitation:

- a) *determining a match between at least one encrypted information file and at least one encrypted search request file without removing said encryption* (participant's encrypted interests are compared without having to decrypt them; see at least paragraph [0005]).
- b) *revealing said match to the sources of said files wherein said match is capable of being decrypted by said services* (De Vries teaches that matched interests are revealed using a display or an output device; see at least paragraph [0046]).
- c) *Concealing non-matches from said sources* (Non-matched interests are not revealed; see at least paragraph [0006]).

Claim 2:

De Vries, as shown below, discloses the following limitation:

a method of claim 1, wherein said encrypted files comprise structured data
("users can search a database of encrypted credentials, identities or interests"; see at least paragraph [0007]).

Claim 3:

De Vries, as shown below, discloses the following limitation:

a method of claim 2, wherein said structured data comprise unencrypted keywords and encrypted vocabulary (unencrypted and encrypted set of interests are stored in a database, see at least paragraph [0044] and see at least Item 205 and 235 of Figure 2).

Claim 4:

De Vries, as shown below, discloses the following limitation:

a method of claim 1, whereby said determining a match is performed by comparing said keywords and said encrypted vocabulary (A match or a partial match is determined by comparing the entire hash, portions of the hashes or individual characters or bits of the hashes; see at least paragraph [0045]).

Claim 5:

De Vries, as shown below, discloses the following limitation:

a) *a means for determining a match between at least one encrypted information file and at least one encrypted search request file without removing said encryption* (A computer system and program modules, 250,255 and 260, compares at least two encrypted or hashed files; see at least paragraph [0045] and Figure 1 and 2).

b) *a means for revealing said match to the sources of said files wherein said match is capable of being decrypted by said services* (Matched interests are disclosed by program module 330; see at least paragraph [0061] and Figure 3).

c) *a means for concealing non-matches from said sources* (Box 340 prevents disclosures of non-matched interests; see at least paragraph [0063] and Figure 3).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The examiner can normally be reached on Mon- Fri 7:30am-5:00PM est. alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Regan can be reached on (571) 270- 1245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit 3621
Date: 3/15/2007

Signature: 

JAMES REAGAN
SUPERVISORY PATENT EXAMINER

